

Application No.: 10/579,659
Filing Date: May 11, 2007

REMARKS

Claims 1-20 are pending. In response to the Office Action sent April 21, 2009, Applicants have cancelled Claim 14. Claims 4, 10, and 19 have been amended to correct minor typographical errors. Support for the amendments can be found throughout the specification and in the original claims as filed. No new matter has been added. Claims 1-13 and 15-20 are presented for examination.

Regarding the Drawings

The drawings were objected to under 37 C.F.R.. §1.83(a) for failing to show every feature of the invention specified in the claims. Specifically, the PTO objected to the drawings because the drawings did not include a securing member as recited in Claim 14. Claim 14 has been cancelled, thereby obviating the objection to the drawings.

The Claims are Novel under 35 U.S.C. § 102 in view of Japanese Document 2001-026918

Claims 1-11 and 15-20 were rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Document 2001-026918. According to the PTO, the Japanese Document discloses a protecting apparatus comprising a bumper member (1), structure positioning member (defined by the T4 distance), a joining member (defined by the H1 distance), a flexible member (defined by H2-H1 distance), and tongues (11a). Applicants respectfully disagree and request withdrawal of the rejection for the following reasons.

The present invention is directed to a protecting apparatus arranged to protect a structure from impact forces. An example of a typical use for the invention would be where a number of such protecting apparatuses are positioned one above the other about a support for a warehouse racking system. These supports are commonly damaged by impact with fork lifts as they are maneuvered around the warehouse transporting pallets or boxes of goods.

Each protecting apparatus includes a bumper member for receiving impact forces and a structure positioning member arranged to be positioned in contact with or adjacent to a portion of the structure. The bumper member is identified in Figure 2 of the present drawings as 12 and the structure positioning member as 14. A first joining member 18a joins a first end of the structure positioning member 14 with a first end of the bumper member 12 and a second joining member 18b joins a second end of the structure positioning member 14 with a second end of the bumper member 12. The structure positioning member 14 and the first and second joining members 18a,

18b define an opening for receiving at least a portion of the structure to be protected. At least one flexible joining portion 16 extends between the bumper member 12 and the structure positioning member 14. When the bumper member 12 is impacted, the impact force is dissipated at least in part by flexure of the joining portion 16.

An important feature of the present invention is the way the opening for receiving at least a portion of the structure is established and how this allows the structure to be received in that opening so that the apparatus effectively “wraps” around a major portion of the periphery of the structure that needs to be protected. This arrangement ensures that the major portion of the structure is then protected from impact because of the relative positioning of the bumper member 12 and that major portion within the opening. This is well illustrated in, for example, Figures 1 and 6.

The pending claims are novel in view of the Japanese Document. Under 35 U.S.C. § 102(b), “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Applicants submit that the Japanese Document does not anticipate Claims 1-11 and 15-20 because it fails to teach each and every element of the claimed invention. As will be described in greater detail below, the differences between the present invention as claimed and the bumper described in the Japanese Document are clear and many.

The Japanese Document describes a fender 1 having a flat impact receiving part 10 and a pair of support leg parts 11. A rib 12 extends between and connects to the support leg parts 11. Each support leg part 11 has a foot 11a for contact with a surface to which the fender 1 is secured. As clearly shown in all of the drawings of the Japanese Document, the fender 11 is arranged to be mounted on the surface to be protected by the fender 1. The Japanese Document does not describe a protecting apparatus that includes an opening for receiving at least a portion of the structure or surface to be protected.

As Claim 1 recites, the first joining member joins a first end of the structure positioning member to a first end of the bumper member and the second joining member joins a second end of the structure positioning member to a second end of the bumper member. The portion H1 of each leg part 11 of the Japanese Document does not join the impact receiving part 10 to the rib

Application No.: 10/579,659
Filing Date: May 11, 2007

12 and hence cannot be equated to a joining member in accordance with the present invention. The portion H2-H1 of each leg part 11 of the Japanese Document does join the impact receiving part 10 to the rib 12. However, portion H2-H1 of each leg part 11 and the rib 12 do not together define an opening for receiving at least a portion of the structure to be protected as required by the present invention. Furthermore, if portion H2-H1 of each leg part 11 of the Japanese Document is equated to a joining portion according to the invention, then the Japanese Document does not teach each and every limitation of the claim as required under 35 U.S.C. §102; namely, the reference does not disclose a flexible joining portion as is presently claimed.

In light of the above comments, Applicants submit that the Japanese Document does not teach each of the features of the present invention as claimed and thus this objection should be withdrawn.

Claims 12 and 13 are Patentably Non-Obvious under 35 USC § 103 in view of the Japanese Document

Claims 12 and 13 were rejected as being obvious under 35 U.S.C. §103. More particularly, Claim 12 was rejected as being unpatentable over Japanese Document as, the PTO opines, the provision of a second tongue element is considered an obvious duplication of parts. Claim 13 was rejected as being unpatentable over Japanese Document in view of the European Document (EP 319362). The European Document discloses a securing member and the PTO concludes that it would have been obvious to one of skill in the art to provide the device shown by the Japanese Document with a securing member as described by the European Document. Applicants disagree.

Regarding Claim 12

It is well settled that the Examiner “bears the initial burden of presenting a *prima facie* case of unpatentability...” *In re Sullivan*, 498 F.3d 1345 (Fed. Cir. 2007). Until the Examiner has established a *prima facie* case of obviousness, the Applicant need not present arguments or evidence of non-obviousness. To establish a *prima facie* case of obviousness, the PTO must establish at least three elements. First, the prior art reference (or references when combined) must teach or suggest all of the claim limitations: “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (CCPA 1970); *see also M.P.E.P. § 2143.03*. Second, there must be a

reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986); *see also M.P.E.P. § 2143.02*. And finally, the Examiner must articulate some reason to modify or combine the cited references that renders the claim obvious. Merely establishing that the claimed elements can be found in the prior art is not sufficient to establish a *prima facie* case of obviousness. Applicants submit that the PTO has failed to cite prior art which establishes a *prima facie* case of obviousness.

The Japanese Document does not teach or suggest each of the features of claim 1. Furthermore, Claim 11 requires the tongue to be located at or adjacent to each of the first and second ends of the bumper member. The impact receiving part 10 of the fender 1 of the Japanese Document has been equated by the PTO to the bumper member of the present invention. The PTO has also equated the feet 11a of the Japanese Document to the tongues of the present invention. However, Applicants submit that the feet 11a cannot be equated to such tongues as the feet are not “located at or adjacent to each of the first and second ends of the bumper member” as required by claim 11.

Courts have further concluded that if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference is not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Applicants assert that the feet 11a of the Japanese Document do not facilitate retention of the protecting apparatus when it is received in the opening as required by Claim 11 because the Japanese Document does not teach such an opening and consequently does not teach location of the part to be protected within such an opening.

The Japanese Document does not teach the tongue of claim 11, nor does it teach or suggest the use of a further tongue as required by claim 12. It should also be noted that claim 12 requires a further tongue to be located “on each of the first and second joining members” and thus defines a location for each tongue. The Japanese Document does not teach or allude to such an arrangement nor would such an arrangement have been obvious in light of the Japanese Document. Accordingly, Applicants submit that Claim 12 is non-obvious under 35 U.S.C. §103(a) in view of the Japanese Document and request withdrawal of the rejection.

Regarding Claim 13

Application No.: 10/579,659
Filing Date: May 11, 2007

Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over the Japanese Document in view of the European Document. In essence, the PTO opined that it would have been obvious to modify the device described in the Japanese Document to include a securing means, as shown in the European Document, to provide a stronger securing means for retaining the apparatus to the structure. Claim 13 does not recite a securing means. Applicants assume, therefore, that the PTO's reference to Claim 13 was erroneous and that the PTO intended, instead, to refer to Claim 14, which defines the securing member. Claim 14 has been cancelled, thereby obviating the rejection.

For at least the reasons above, Applicants respectfully request reconsideration and withdraw of the 35 U.S.C. § 103(a) rejection of the pending claims over the cited references.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

CONCLUSION

In view of the above amendments and remarks, Applicants respectfully maintain that the claims are patentable and request that they be passed to issue. Applicants invite the Examiner to call the undersigned if any remaining issues may be resolved by telephone.

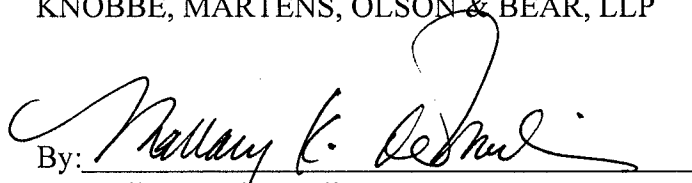
Application No.: 10/579,659
Filing Date: May 11, 2007

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: September 18, 2009

By: 
Mallery K. de Merlier
Registration No. 51,609
Attorney of Record
Customer No. 20995
(619) 235-8550

7827420
091809